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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,630	06/27/2003	Per Martinsson	930010-2206	8456

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FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/608,630

Applicant(s)

MARTINSSON ET AL.

Examiner

Andrew T. Piziali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 5, 7-12, 19, 21-26 and 29-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 13-18, 20, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/9/04 &amp; 4/5/04</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Species 1, claims 1-4, 6, 13-18, 20 and 27-28 in the reply filed on 4/7/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Response to Amendment***

2. The amendment filed on 4/7/2005 has been entered.

### ***Claim Objections***

3. Claims 13 and 27 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Filaments are necessarily either round or non-round in shape. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form.

4. Claims 27 and 28 are objected to because of the following informality: The claims are drawn to the filament of claim 15, but claim 15 is drawn to a fabric. It appears that the claims were intended to be drawn to the fabric of claim 15. Appropriate correction is required.

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States;

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 3,800,019 to Parsey et al. (hereinafter referred to as Parsey).

Regarding claims 1-4, 6 and 13, Parsey discloses a filament having a core surrounded by a plurality of respective outer layers of different colors (see entire document including column 2, lines 8-29).

Regarding claim 2, Parsey discloses that the core is made of a different material than the coatings (column 1, line 4 through column 2, line 30).

Regarding claims 3-4, the different colored outer coating layers indicate the level of wear associated with a wear level through the respective layers.

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Regarding claim 6, although Parsey does not specifically disclose that the core and the respective layers are visibly distinguishable from one another, based on the different materials used for the core (synthetic or glass) compared to the coating (organic), it appears that the core would be visibly distinguishable from the respective layers.

Regarding claim 13, a filament is necessarily either round or non-round in shape.

8. Claims 1-4, 6 and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 6,653,943 to Lamb et al. (hereinafter referred to as Lamb).

Regarding claims 1-4, 6 and 13, Lamb discloses a filament having a core surrounded by a plurality of respective outer layers of different colors (see entire document including column 4, lines 19-35).

Regarding claim 2, Lamb discloses that the core is made of a different material than the coatings (column 1, lines 6-24 and column 4, lines 19-35).

Regarding claims 3-4, the different colored outer coating layers indicate the level of wear associated with a wear level through the respective layers.

Regarding claim 6, although Lamb does not specifically disclose that the core and the respective layers are visibly distinguishable from one another, based on the different materials used for the core (metal) compared to the coating (synthetic plastic material), it appears that the core would be visibly distinguishable from the respective layers.

Regarding claim 13, a filament is necessarily either round or non-round in shape.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-4, 6, 13-18, 20 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,685,014 to Dapsalmon in view of any one of USPN 3,800,019 to Parsey or USPN 6,653,943 to Lamb.

Regarding claims 1-4, 6, 13-18, 20 and 27-28, Dapsalmon discloses a filament having a core (color A) surrounded by an outer layer (color B) (see entire document including column 1, line 63 through column 2, line 26). Dapsalmon does not specifically mention the use of a plurality of respective outer layers, but Parsey and Lamb each disclose that it is known in the wear detecting filament art that a core may be surrounded by a plurality of outer layers to indicate the degree of wear (see entire documents including column 2, lines 8-29 of Parsey and column 4, lines 20-35 of Lamb). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the filament of Dapsalmon with a plurality of outer layers, because the plurality of outer layers allow for the indication of the degree of wear.

Regarding claims 2-4, 6, 16-18 and 20, Dapsalmon discloses that the core and the outer layer may be distinguishable from one another by different color (column 1, line 63 through column 2, line 26).

Regarding claim 13, a filament is necessarily either round or non-round in shape.

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Regarding claims 14 and 28, Dapsalmon discloses that the filament may comprise a multifilament core-spun yarn (column 3, lines 57-60).

Regarding claims 15-18, 20 and 27-28, Dapsalmon discloses that the filament may be used to make a fabric (paragraph bridging columns 1 and 2).

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-4, 6, 13-18, 20 and 27-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,786,243 to Moriarty et al. (hereinafter referred to as Moriarty) in view of any one of USPN 3,800,019 to Parsey or USPN 6,653,943 to Lamb.

Regarding claims 1-4, 6, 13-18, 20 and 27-28, Moriarty discloses a filament having a core (color A) surrounded by an outer layer (color B) (see claim 18). Dapsalmon does not specifically mention the use of a plurality of respective outer layers, but Parsey and Lamb each disclose that it is known in the wear detecting filament art that a core may be surrounded by a plurality of outer layers to indicate the degree of wear (see entire documents including column 2,

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lines 8-29 of Parsey and column 4, lines 20-35 of Lamb). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the filament of Moriarty with a plurality of outer layers, because the plurality of outer layers allow for the indication of the degree of wear.

Regarding claims 2-4, 6, 16-18 and 20, Moriarty discloses that the core and the outer layer may be distinguishable from one another by different color (claim 18).

Regarding claim 13, a filament is necessarily either round or non-round in shape.

Regarding claims 14 and 28, Moriarty discloses that the filament may comprise a multifilament yarn (claim 5).

Regarding claims 15-18, 20 and 27-28, Moriarty discloses that the filament may be used to make a fabric (claim 1).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

atp

*gzb 4/27/05*  
**ANDREW T. PIZALI**  
PATENT EXAMINER

*Terrel Morris*  
**TERREL MORRIS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700